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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,460	12/14/2001	Michael Gauselmann	M-12238-1P US	1710

32566 7590 11/16/2005

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EXAMINER

BROCKETTI, JULIE K

ART UNIT PAPER NUMBER

3713

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/022,460	Applicant(s) GAUSELMANN, MICHAEL	
	Examiner Julie K. Brockett	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 20-22, 24-39 and 41-43 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-18, 20-22, 24-39 and 41-43 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/952613.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 12, 2005 has been entered.

Priority

Applicant is reminded of the continued obligation to update the priority claim in the specification. For example, Applicant must amend the specification to state that the parent application has been abandoned.

Claim Objections

Claim 41 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 39. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Claim 41 only additionally recites that the conversion is to a different symbol,

different from the special symbol. However, this claim limitation is in claim 24 on which claim 39 is based, therefore, both claims encompass the exact same limitations.

Claim Rejections - 35 USC § 112

The following is a quotation of the fourth paragraph of 35 U.S.C. 112:

A claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed.

Claims 7-10, 12, 21, 29-32, 34 and 42 are rejected under 35 U.S.C. 112 fourth paragraph for failing to further limit the subject matter of a previous claim. Claims 1 and 24 now recite "...said converting comprises changing any symbols on a pay line to the left of the special symbol, on the same pay line, to a leftmost symbol on said pay line or converting any symbols on said pay line to the right of said special symbol, on the same pay line, to a rightmost symbol on said pay line".

Claims 7, 9, 29 and 31 state "...converting symbols to the left/right of said special symbol in said row to another symbol." This claim is now broader than claim 1 and as such it does not further limit the subject matter of claim 1.

Claims 8, 10, 30 and 32 state "...converting said symbols to the left/right of said special symbol to a symbol in the leftmost/rightmost position of said row." This is exactly what amended claim 1 now recites, so this claim does not further limit the subject matter of claim 1.

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Claims 12 and 34 state "...converting comprises converting symbols in certain positions in said matrix to other symbols." This claim is now broader than claim 1 and as such it does not further limit the subject matter of claim 1.

Claim 21 and 42 state, "...converting at least one symbol on a pay line to another symbol on the pay line". This claim is now broader than claim and as such it does not further limit the subject matter of claim 1.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 12-15, 18, 20-22, 24-32, 34-36, 39 and 41-43 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bennett, U.S. Patent No.

6,089,977. Bennett discloses a gaming method and device. A combination of symbols in a matrix of M rows and N columns are selected and displayed on a display device. Control circuitry is used for controlling the display device. The selected symbols including at least one special symbol, i.e. the iceberg or coin, and other symbols (See Bennett col. 3 lines 9-37; Fig. 1). At least one of the other symbols is converted to at least one different symbol, different from the special symbol due to the at least one special symbol being selected for the matrix (See Bennett col. 3 lines 35-67; col. 4 lines 1-67). The converting comprises changing any symbols on a payline to the left of the special symbol, on the same pay line, to a leftmost symbol on the payline or converting any symbol on the pay line to the right of the special symbol on the same pay line to a rightmost symbol on the pay line (See Bennett col. 4; col. 5) [claims 1, 7-10, 12, 24]. For example, when the ICE and J/B symbol, i.e. special symbols, appear on the reels, a penguin symbol appears, and beings to roam around the display. The penguin moves to the next symbol in the matrix and thereby converts that symbol to "a different symbol" different from the special symbol, i.e. it changes to a penguin. Bennett further discloses that the converting comprises changing any symbols on a pay line to the left of the special symbol on the same pay line to a leftmost symbol on the pay line. For example, in

looking at col. 4 lines 27-32 of Bennett one sees the special symbol J/B on reel 5, and there are 4 symbols to the left of that special symbol. The Penguin symbol appears on reel 2 and by its presence, it effectively “changes” the symbol that was originally on reel 2, i.e. a J, to an SE. For example, the penguin acts as a wild and when it appears on reel 2 it acts as an SE so that a winning combination of two SE’s in a payline result in an award. A similar situation exists when the special symbol is ICE and the penguin replaces a symbol to the right of the special symbol with the last symbol in the pay line. Consequently, Bennett anticipates the claim if one equates “changing any symbol on a pay line” to the fact that the penguin is wild and therefore “changes” into the leftmost/rightmost symbol, i.e. the WH or SE symbol. If one does not believe that Bennett anticipates the claim language, the Examiner notes that it would have been obvious to one of ordinary skill in the art to physically change the penguin into an SE symbol so that the player knows the type of winning combination he has achieved and can therefore see what combination they are being awarded for generating.

Bennett further discloses displaying the matrix (See Bennett Fig. 1) [claim 2]. The displayed symbols in the matrix are converted to different symbols due to the at least one special symbol being selected for the matrix (See Bennett col. 3 lines 34-67) [claims 3, 25]. A pseudo random number generator is used to identify the symbols for the matrix (See Bennett col. 1 lines 64-66) [claims 4, 26]. An award is provided for certain combinations across

one or more pay lines (See Bennett col. 1 lines 66-67) [claims 5, 27]. It is a 3 x 5 matrix (See Bennett col. 2 line 67) [claims 6, 28]. The at least one special symbol is selected for a position in a row and column in the matrix. The converting comprises converting symbols to the left/right of the special symbol in the row to another symbol (See Bennett col. 5 lines 11-15; col. 4 lines 28-32) [claims 7, 9, 12, 29, 31, 34]. The symbols to the left/right of the special symbol are converted to a symbol in the leftmost/rightmost position in the row (See Bennett col. 4 lines 28-32; col. 5 lines 11-15) [claims 8, 10, 30, 32]. For example, in col. 4 lines 28-32 the J changes to a penguin, which changes to an SE and in col. 5 lines 11-15 if the penguin appeared on reel 4 it would change to a WH symbol. Converting comprise converting a visual image of initially selected symbols to a converted symbol (See Bennett col. 3 lines 33-67) [claim 13]. The special symbol is a wild card, which represents a symbol of a highest value across a payline (See Bennett col. 2 lines 23-30) [claims 14, 35]. It is an art rule is that when a wild card occurs, it will represent the symbol, which will give the player the highest payout for a line, thus representative of the symbol with the highest value. Determining after converting, whether symbols in the matrix include a winning combination of symbols by determining symbols across at least one payline by use of a payout table (See Bennett col. 3 lines 45-55) [claim 15, 36]. Converting comprise randomly selecting certain ones of the other symbols for conversion to said different symbol, different from the special symbol (See Bennett col. 3 lines 35-67) [claims 18, 20, 39, 41]. Converting

comprises converting at least one symbol on a pay line to another symbol on the pay line (See Bennett col. 3 lines 35-67) [claims 21, 42]. Converting comprises converting the special symbol to another symbol selected by a player (See Bennett col. 3 lines 35-67) [claims 22, 43].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 16, 33 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Halloran, U.S. Patent No. 6,439,993 B1.

O'Halloran discloses a gaming method and device. A combination of symbols in a matrix of M rows and N columns are selected and displayed on a display device. Control circuitry controls the display device. The selected symbols include at least one special symbol and other symbols (See O'Halloran Fig. 2; col. 2 lines 54-55). At least one other symbol is converted to at least one different symbol due to the at least one special symbol being selected for the matrix (See O'Halloran col. 3 lines 1-9; Fig. 4a-4f). The special symbol is selected for a position in a row and column in the matrix (See O'Halloran Fig. 2). The converting comprises converting symbols adjoining the special symbol

on a pay line to the special symbol (See O'Halloran col. 3 lines 1-9) [claims 11, 33]. Multiple pay lines comprise horizontal pay lines (See O'Halloran col. 2 lines 41-43; Fig. 4a-4f) [claims 17, 37]. O'Halloran lacks in specifically disclosing converting "all" symbols adjoining the special symbol on "multiple" paylines to special symbols identical to the special symbol. However, O'Halloran discloses in one embodiment that when the special symbol occurs, the substitution can occur on adjacent reels so as to be contiguous on a win line (Column 1, lines 48-51). O'Halloran also discloses that other variations and modification are within the scope of the invention including alternates or changes to steps disclosed therein. Hence, from the disclosure of O'Halloran a skilled artisan would find it obvious to convert all symbols that are adjoining the special symbol. One of ordinary skill in the art would thus find it obvious based upon the disclosure of O'Halloran to allow for a different pattern of symbols to be changed than those adjacent. One would be motivated to do so based upon the disclosure of O'Halloran that other variations are obvious as well as the fact that allowing different symbols to change based on different positions, the game would become more interesting as one would not be able to predict which symbols would be changed. O'Halloran even addresses this motivation in stating that if gambling machines lack variety, players will lose interest (Column 1, lines 20-22) thus a skilled artisan would be strongly motivated to follow this advice as well as the various embodiments dictated as

obvious to allow for the special symbol to convert symbols in different places thus creating a game of variety that would not bore players.

Claims 17 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Halloran, in view of Mayeroff, U.S. Patent No.

6,224,483 B1. O'Halloran discloses multiple paylines but does not disclose the payline being bent. Mayeroff discloses that a popular payline format on a 3x5 slot is the Australian style, which comprises nine different paylines, including bent ones (Columns 1 and 2). Mayeroff further discloses that a plethora of winning symbol combinations is provided so that the player has a large number of various opportunities to win (Column 3, lines 9-12) [claims 17, 38]. It would have been obvious to one of ordinary skill in the art to use a bent payline configuration in the O'Halloran machine in order to provide the player with more betting opportunities, thus increasing their excitement and anticipation. Further, the usage of one payline over another is a design choice, obvious to one of ordinary skill in the art, and motivated by the wants and needs for a system as defined by its designer.

Response to Amendment

It has been noted that claims 1, 11, 24 and 33 have been amended.

Response to Arguments

Applicant's arguments filed August 8, 2005 have been fully considered but they are not persuasive.

Applicant argues that in Bennett there is no suggestion of converting symbols to the leftmost or rightmost symbol. The Examiner disagrees and notes her explanation in the rejection above. It is not that the symbols are being turned into an Iceberg or Coin symbol; instead they are being turned into the symbol that would make a winning combination such as an SE or WH symbol, i.e. the rightmost or leftmost symbol.

Applicant argues that neither O'Halloran nor Bennett suggest, "converting all symbols adjoining the special symbol on multiple pay lines to special symbols identical to the special symbol". The Examiner agrees that this limitation is not expressly taught by O'Halloran, but it is obvious as stated for the reasons above.

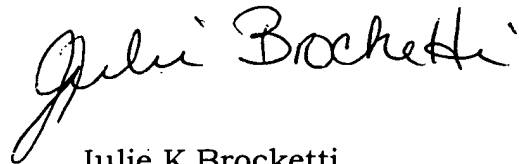
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K. Brockett whose telephone number is 571-272-4432. The examiner can normally be reached on M-Th 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Julie K Brockett
Primary Examiner
Art Unit 3713